

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant has amended the priority data to reflect the fact that the instant application is a Divisional of U.S. Patent Application No. 09/507,336, rather than a continuation. Since this shift in priority is merely a change in the type of benefit claimed, rather than a new claim for earlier benefit of an earlier application, and further, since the claim for benefit per se was already extant in the instant application, the shift appears to be allowable under 37 C.F.R. 1.78(a)(2)(ii).

The instant application now being filed as a Divisional of US Patent Application Serial No. 09/507,336, a shift of the invention desired to be examined is appropriate. Accordingly, applicant has elected to prosecute group IV, which is now covered by claims 83-95, with claims 50-54 now being withdrawn from consideration.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 83, 89, 90, and 94 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Choy.

See Figure 1, wherein the distal tip of the device is the outer lip, the laser fiber is the ablating element, the ring of illumination fibers (see Figure 4) constitutes an inner lip, the portion of the device distal of the tip of the optical fiber constitutes a suction well, the annular volume surrounding the fiber constitutes fluid chamber, and the portion of the catheter proximal of the

fiber is the suction lumen, the suction port being that portion of the catheter coupled to the suction source.

Claims 83, 89, 90, and 94 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Vierra et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84-88, 91-93, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choy. Choy teaches a device as claimed except the multiple wells, the sensors and the particular ratio of the suction lumen cross section to the vacuum port cross section. It would have been obvious to the artisan of ordinary skill to provide multiple ports for multiplied effect, such as operating on multiple cardiac vessels simultaneously, and to provide a pressure, flow rate, or electrical sensor since these are equivalent to the reservoir 30 of Choy, as they would serve to distinguish when the thrombus is breached and provide no unexpected result, and to provide the particular ratio of the port cross section to the lumen cross section since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result, thus producing a device such as claimed.

Claims 84-88, 91-93, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al. Vierra et al teaches a device as claimed except the multiple wells, the sensors and the particular ratio of the suction lumen cross section to the vacuum port cross section. It would have been obvious to the artisan of ordinary skill to provide multiple ports for multiplied

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effect, such as operating on multiple cardiac vessels simultaneously, and to provide a pressure, flow rate, or electrical, sensor since these are equivalent to the reservoir 30 of Choy, as they would serve to distinguish when the thrombus is breached and provide no unexpected result, and to provide the particular ratio of the port cross section to the lumen cross section since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 83-95 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 5,830,214. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent application claims. Here, the patent application claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or

narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 83-95 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent Application No. 11/882,072. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims 83-95 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/  
Primary Examiner, Art Unit 3735